

EG



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
08/787,745	01/24/1997	JOHN B. HOEFELICH	29124-009	6904

7590 01/29/2004

FAY, SHARPE, BEALL, FAGAN, MINNICH &
MCKEE
1100 SUPERIOR AVENUE, SUITE 700
CLEVELAND, OH 441142518

EXAMINER

BLAU, STEPHEN LUTHER

ART UNIT	PAPER NUMBER
----------	--------------

3711

DATE MAILED: 01/29/2004

33

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Applicati n No.

08/787,745

Applicant(s)

HOEFELICH ET AL.

Examiner

Stephen L. Blau

Art Unit

3711

-- Th MAILING DATE of this communication appears on th cov r sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 24 November 2003.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-3, 5-9 and 11-21 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 1-3, 5-9, 11, 12 and 19-21 is/are allowed.
- 6) ☒ Claim(s) 13-18 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. §§ 119 and 120

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
* See the attached detailed Office action for a list of the certified copies not received.
- 13) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application) since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.
a) ☐ The translation of the foreign language provisional application has been received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121 since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____
- 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

DETAILED ACTION

Claim Rejections - 35 USC § 103

1. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

2. Claims 13-16 and 18 are rejected under 35 U.S.C. 103(a) as being unpatentable over Akatsuka (5,437,450) in view of Meredith.

Akatsuka discloses an elongated tubular shaft (Col. 5, Lns. 62-68) comprising a plurality of layers of fibers embedded in a synthetic resin (Figure, Col. 4 Lns. 24-35, Col. 5 Lns. 1-7), a butt section having a diameter between .400 and .540 inches in the form of a grip end inside diameter of 11.5-14.5 mm with a wall thickness of .5-2 mm (Col. 5, Lns. 62-68), a butt section transitioning without intervening discontinuities to a tapered intermediate section, a tapered intermediate section tapering without intervening discontinuities to a relatively smaller diameter tip section in a form of an outer diameter gradually increasing from one end adjacent to a tip end of a shaft to an other end adjacent to a grip end of a shaft (Col. 3 Lns. 56-60), a tip section including a portion having an outside diameter adapted to be fitted to the hosel of a club head in the form of an outer diameter size of a tip end (Col. 5, Lns. 62-68), and a shaft length of 45 inches (Col. 7, Ln. 34).

Akatsuka lacks a butt section comprising a substantially cylindrical cross section, a butt section and tip section including parallel sidewalls and a kick point above a center of a shaft.

Meredith discloses a butt section and tip section being substantially cylindrical in cross section (Fig. 1, Col. 2, Lns. 34-47). In view of the patent of Meredith it would have been obvious to modify the shaft of Akatsuka to have a butt section comprising a cylindrical cross section with parallel sidewalls in order to have a similar feel along the butt section when gripped by a player at different points. In addition, in view of the patent of Meredith it would have been obvious to modify the shaft of Akatsuka to have a tip section having parallel side walls in order to facilitate the adaptation of inserting a tip section of a shaft into a neck of a head which is a cylindrical shape.

Meredith discloses a shaft having a kick point above a center point of a shaft (Fig. 8, Col. 1, Lns. 16-23) in order to lower the angle of trajectory who tends to hit the ball too high (Col. 1, Lns. 24-37) and designing a kick point without using a discontinuity but using gradual changes in shaft diameter and shaft wall thickness (Figs. 1, 7). In view of the patent of Meredith it would have been obvious to modify the shaft of Akatsuka to have a kick point above the center point of a shaft in order to provide a shaft for a club which produces a lower angle of trajectory for a player who tends to hit a ball too high and in order to increase the velocity of a head at impact by using more of the shaft to snap back at impact thus increasing hitting distance.

3. Claim 17 is rejected under 35 U.S.C. 103(a) as being unpatentable Akatsuka (5,437,450) in view of Meredith as applied to claims 13-16 and 18 above, and further in view of Melin.

Akatsuka discloses a butt diameter of .492 inches (12.5mm) (Col. 5, Lns. 66-68).

Akatsuka lacks a butt diameter between .450 to .475 inches (11.43- 12.06 mm). Melin discloses a golf club having a handle with a diameter of .31847 to 1.274 inches (8-16 mm) in the form of a circumference in the range of 1-4 inches (Col. 3, Lns. 30-33) and handles used for the very young and very weak (Col. 1, Lns. 29-34). In view of the patent of Melin it would have been obvious to modify the shaft of Akatsuka to have a shaft with a butt diameter between .450 to .475 inches in order to provide a shaft more light and more flexible to a weaker player who swings a shaft at a slower speed and in order to provide a shaft with a small diameter to a player as a child who has smaller hands.

Allowable Subject Matter

4. Claims 1-3, 5-9, 11-12 and 19-21 are allowed.

Response to Arguments

5. The argument that it is improper to combine the references of Akatsuka in view of Meredith due to the lack of motivation the Board of Appeal noted in the opinion of December 23, 2002 with respect to claim 1 is disagreed with. Claim 13 has different structure than claim 1 and the Board did not rule on the allowability of this claims due to the indefiniteness of this claim previously written before the Board. In fact the Board caution the examiner to not overlook the prior art which has been used should the indefiniteness be overcome (See page 15 of opinion of December 23, 2002). The argument that it is improper to combine the references

Art Unit: 3711

of Akatsuka and Meredith due to neither teaching or suggestion a butt section diameter displacing the kick point above the center point of a shaft is disagreed with. Meredith clearly discloses a kick point above a center point of the shaft. The structure of the entire shaft including the butt section diameter make up the location of a kick point of a shaft. Since this is an apparatus claim very little weight is give to how a shaft is made. Thus modifying the structure of the butt section diameter from a previous design to displace or locate kick point is given no weight. Due to the new rejection of claim 17 this action is not made final.

Conclusion

6. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Steve Blau whose telephone number is (703) 308-2712. The examiner is available Monday through Friday from 8 a.m. to 4:30 p.m.. If the examiner is unavailable you can contact his supervisor Paul Sewell whose telephone number is (703) 308-2126. Any inquiry of a general nature or relating to the status of this application should be directed to the Group receptionist whose telephone number is (703) 308-0858. (TC 3700 Official Fax 703-872-9302, TC 3700 After Final Fax 703-872-9393)

Slb/ 26 January 2004


STEPHEN BLAU
PRIMARY EXAMINER